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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,784	10/16/2001	Toshiyasu Ito	04208.0112	8751
22852	7590	12/10/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			FIGUEROA, FELIX O	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,784

Applicant(s)

ITO ET AL.

Examiner

Felix O. Figueroa

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

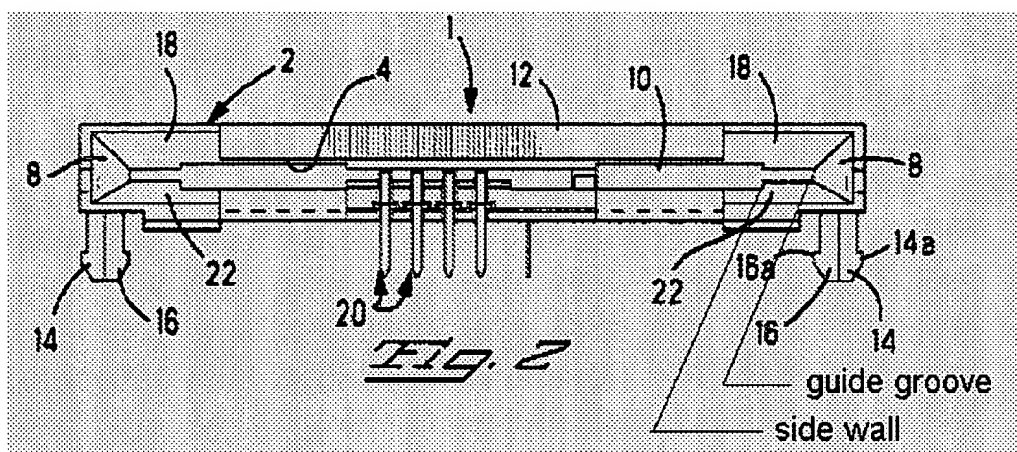
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 7, 8, 11, 12 and 14-22 and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Asakawa (US 6,135,809).

Asakawa discloses a card connector configured to hold a first card and configured to hold a second card, and comprising: a pair of guide grooves (see following figure) formed on both sidewalls of a connector housing (2); and sidewalls (see following figure) to define, below a space between the pair of guide grooves, and a base plate with a plurality of contact terminals arranged in the base plate to couple with contact of a bottom surface of a card. Asakawa also discloses a first space (between the sidewalls) configured to accommodate a lower body portion of a first card, and a second space (between the guide grooves). Please note that the recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Additionally, recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).



Regarding claims 2, 12 and 22, Asakawa discloses the sidewalls formed at such locations that they can guide the side surfaces of a lower body portion of a first card (C).

Regarding claims 5, 6, 15, 25 and 26 Asakawa discloses a housing top plate that forms upper walls of the guide grooves is formed with an opening / a recess (adjacent 12) having a width larger than a lower body portion of a first card, i.e. a least the same size as the separation between the side walls.

Regarding claims 7, 8, 11, 17, 18, 27 and 28, please note that anyone of the terminals 20/50 work as a braking piece.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 9, 10, 13, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakawa in view of Horie (US 6,231,360).

Asakawa discloses substantially the claimed invention except for the eject mechanism. Horie teaches a card connector having an ejector mechanism (11) to help withdraw a card from the socket. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the card connector of Asakawa having an ejector mechanism, as taught by Horie, to help withdraw a card from the socket.

Regarding claim 4, Asakawa discloses the braking piece secure to a position which is far part of the guide groove.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In response to Applicant's arguments that Asakawa "cannot hold a first card of the type required by claims 1 and 11" because "partition 28 divides the space between the side walls" and would interfere with, and would not be 'configured to hold' a card having 'stepped portions' formed along both side edges of the card by a bottom surface of said upper body portion and a bottom surface of said lower body portion, please note that the claims do not specify the extend of the lower body portion. The connector of Asakawa can receive a card with a lower body portion that extends on either side of portion 28, as seen from the view on Figure 2. Thus, the card connector of Asakawa is configured to hold a card having stepped portions formed along both side edges of the

space to accommodate a lower portion of a card

**Fig. 2**

In response to Applicant's arguments that "[c]laim 21 requires a first space unobstructed across the width of said lower body portion of the entire length of said first space", please note that any of the spaces, as shown in the previous figure, is unobstructed along a respective length.

In response to Applicant's arguments that the contacts 20, 50 are not "arranged at such a position that the elastic braking piece engages the bottom surface of the upper body portion of said first card when said first card is inserted and engages the bottom surface of the card body portion of said second card when said second card is inserted," please note that Asakawa discloses the contacts 20 and 50 contacting the terminals of the card (C,C') which are on a bottom surface of the upper body portion.

In response to Applicant's arguments against Horie, please note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, please note that the recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Additionally, recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Asakawa teaches a card connector configured to hold a first card having an upper body portion, a lower body portion formed narrower than the upper body portion... and stepped portions formed along both side edges of the card by a bottom surface of the upper body portion and a bottom surface of the lower body portion.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 Ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ffr



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